

EXHIBIT A

§ 4:8

LIPSCOMB'S WALKER ON PATENTS

*Re Application of Meyer*¹³ that, "The genus, 'alkaline chlorine or bromine solution,' does not identically disclose or describe within the meaning of 102, the species alkali metal hypochlorite, since the genus would include an untold number of species."¹⁴ It sometimes happens that a specie may be patentable in spite of a prior art genus,¹⁵ but usually the prior genus will render the later specie claim obvious.¹⁶

§ 4:9 Accidental, Unrecognized, Unintentional or Unintroduced Anticipation

Accidental results, not intended and not appreciated, do not constitute an anticipation.¹⁷

Novelty is not negated by any prior accidental occurrence or production, the character and function of which was not recognized until later than the date of the patented invention sought to be anticipated thereby.¹⁸ In the case of *Tilghman v*

13. *Re Application of Meyer*, 599 F2d 1026, 202 USPQ 175 (1979, CCPA).

14. 202 USPQ at 179.

15. *Application of Ornitz*, 54 CCPA 1304, 376 F2d 330, 153 USPQ 453 (1967).

16. *California Research Corp. v Ladd*, 123 App DC 60, 356 F2d 813, 148 USPQ 404 (1966).

17. *Eibel Process Co. v Minnesota & Ontario Paper Co.*, 261 US 45, 67 L Ed 523, 43 S Ct 322 (1923); *United Shoe Machinery Corp. v Day Wood Heel Co.*, 46 F2d 897, 8 USPQ 364 (1931, CA6 Ohio); *Toch v Zibell Damp Resisting Paint Co.*, 233 F 993 (1916, CA2 NY); *Wickelman v A. B. Dick Co.*, 88 F 264 (1898, CA2 NY).

18. *Metal Cutting Tool Service v National Tool Co.*, 103 F2d 581, 41 USPQ 688 (1939, CA6 Ohio); *J. C.*

Ferguson Mfg. Works, Inc. v American Lecithin Co., 94 F2d 729, 37 USPQ 4 (1938, CA1 RI); *McKee v Graton & Knight Co.*, 87 F2d 262, 32 USPQ 89 (1937, CA4 NC); *H. K. Regar & Sons v Scott & Williams, Inc.*, 63 F2d 229, 17 USPQ 81 (1933, CA2 NY); *United Chromium, Inc. v International Silver Co.*, 60 F2d 913, 15 USPQ 51 (1932, CA2 Conn); *Smith v Prutton*, 127 F2d 79, 53 USPQ 412 (1942, CA6 Ohio); *Cleveland Trust Co. v Schriber-Schroth Co.*, 108 F2d 109, 43 USPQ 204 (1940, CA6 Ohio) *revd on other grounds* 311 US 211, 85 L Ed 132, 61 S Ct 235, 47 USPQ 345; *Carson v American Smelting & Refining Co.*, 11 F2d 766 (1926, CA9); *United Verde Copper Co. v Peirce-Smith Converter Co.*, 7 F2d 13 (1925, CA3 Del); *Fulton Co. v Bishop & Babcock Co.*, 284 F 774 (1922, CA6 Ohio); *Munising Paper Co. v American Sulphite Pulp Co.*, 228 F 700

Proctor,¹⁹ the Supreme Court held:

We do not regard the accidental formation of fat acid in Perkin's steam cylinder from the tallow introduced to lubricate the piston, if the scum which rose from the water issuing from the ejection pipe was fat acid, as of any consequence in this inquiry. What the process was by which it was generated or formed was never fully understood. Those engaged in the art of making candles, or in any other art in which fat acids are desirable, certainly never derived the least hint from this accidental phenomenon in regard to any practicable process for manufacturing such acids. . . . The accidental effects produced in Daniel's water barometer and in Walther's process for purifying the fats and oils preparatory to soap making, are of the same character. They revealed no process for the manufacture of fat acids. If the acids were accidentally and unwittingly produced, whilst the operators were in pursuit of other and different results, without exciting attention and without its even being known what was done or how it had been done, it would be absurd to say that this was an anticipation of Tilghman's discovery.²⁰

The courts have, since *Tilghman*, consistently held that unintended and unrecognized prior production does not negate novelty.

The reason for this rule arises out of that point of patent law policy which rewards persons for teaching the public how to

(1915, CA6 Mich); *Edison Electric Light Co. v Novelty Incandescent Lamp Co.*, 167 F 977 (1909, CA3 Pa); *Hillard v Fisher Book Type-writer Co.*, 159 F 439 (1908, CA2 NY); *Western Tube Co. v Rainear*, 156 F 49 (1907, CC Pa) *affd* (CA3 Pa) 159 F 431; *Wickelman v A. B. Dick Co.*, 88 F 264 (1898, CA2 NY); *International Nickel Co. v Ford Motor Co.*, 166 F Supp 551, 119 USPQ 72 (1958, DC NY); *Byerley v Barber Asphalt Paving Co.*, 230 F 995 (1916, DC W Va); *Anthracite Separator Co. v Pollock*, 175 F 108 (1909, CC Pa); *Tannage Patent Co. v Donallan*, 93 F 811 (1899, CC Mass);

Chase v Fillebrown, 58 F 374 (1893, CC Mass); *Pittsburgh Reduction Co. v Cowles Electric Smelting & Aluminum Co.*, 55 F 301 (1893, CC Ohio); *General Tire & Rubber Co. v Jefferson Chemical Co.*, 497 F2d 1283, 182 USPQ 70 (1974, CA2 NY); *Application of Felton*, 484 F2d 495, 179 USPQ 295 (1973, CCPA); *Van Veen v United States*, 181 Ct Cl 884, 386 F2d 462, 151 USPQ 506, 156 USPQ 403 (1967).

19. *Tilghman v Proctor*, 102 US 707, 26 L Ed 279 (1881); See J. Kilyk, *Accidental Prior Use*, 64 J Pat Off Soc 392 (1982).

20. 102 US at 711.

perform processes and construct things which nobody else in the United States knew how to perform or to construct, and relevant to which no adequate information could be found in any public patent or printed publication anywhere in the world. But novelty is negated by proof of prior use of a process where that use was understood in point of method, though not correctly understood in point of result.²¹

In *Georgia-Pacific Corp. v United States Plywood Corp.*,²² the court held that a patent which teaches that edge effects and checking of plywood could be materially reduced by striating the panel with multiple and alternating grooves cut to a substantial depth is not anticipated by prior art which employed similar but shallower grooves to create a decorative effect in shingles. There the prior art had undoubtedly improved strength to some degree through striation, but had not appreciated this quality. The court wrote, "Benefits incidentally and accidentally accruing in the products of the prior art do not necessarily negate invention in a change in degree when the purpose is different and the results new and useful."²³ Certainly, where the patented product was not even deliberately sought by the prior art, it would follow a fortiori from the *Georgia-Pacific* case that anticipation cannot be predicated on such a tenuous relationship.

Where the allegedly anticipating product was produced merely by chance and never recognized nor appreciated, one who later discovers and recognizes the product may patent it.²⁴ Even where the allegedly anticipating product was deliberately sought and obtained by the prior art, the discovery of a new use need not be invalidated by anticipation. As Judge Learned

21. *Dorlan v Guie*, 25 F 816 118 USPQ 122 (1958, CA2 NY).

(1885, CC Pa); *Schultz Belting Co. v Willemssen Belting Co.*, 40 F 156 1. 118 USPQ at 129.

(1889, CC Mo). 2. *International Nickel Co. v Ford Motor Co.*, 166 F Supp 551, 119 USPQ 72 (1958, DC NY).

Hand observed in *H. K. Regar & Sons v Scott & Williams, Inc.*³

When old devices are changed at all, the change may be dictated by a new conception, which it took originality to conceive. Strictly, the old device is not then put to a new use, the new use begets a new device. In such cases it requires but little physical change to make an invention.⁴

The *Tilghman* rationale was applied to a product patent in *Pittsburgh Iron & Steel Foundries Co. v Seaman-Sleeth Co.*⁵ There the court, in finding that the plaintiff's patent on an iron alloy known as "Adamite" had not been anticipated by prior alloys of similar analysis, wrote:

If any of the alleged anticipating alloys was Adamite, that fact, so far as the record shows, was not known to those who produced it or used it, and not being recognized as a new product with its distinctive characteristics, its production was purely an accident without profit to the art and without value as an anticipation. We are satisfied, therefore, that Adamite has not been anticipated by alloys, which while accidentally of the same analyses were not shown to be the "article of manufacture" of the patent.⁶

"It has never been the law that unrecognized or unappreciated coproduction of a small amount of a compound without a suggestion of that fact being shown in the prior art can be held as anticipating that compound," said the court in *Pfizer, Inc. v International Rectifier Corp.*⁷

The accidental production of the result attained by the patented improvement under unusual conditions, when the result was not intended and not appreciated, does not constitute

3. *H. K. Regar & Sons v Scott & Williams, Inc.*, 63 F2d 229, 17 USPQ 81 (1933, CA2 NY).

4. 63 F2d at 231.

5. *Pittsburgh Iron & Steel Foundries Co. v Seaman-Sleeth Co.*, 248 F

705 (1917, CA3 Pa).

6. 238 F at 708-709.

7. *Pfizer, Inc. v International Rectifier Corp.*, 545 F Supp 486, 207 USPQ 397 at 414 (1980, CD Cal), affd (CA9 Cal) 685 F2d 357, 217 USPQ 39.

anticipation.⁸ Novelty is not negated by anything which was neither designed, nor apparently adapted, nor actually used, to perform the function of the thing covered by the patent, though it might have been made to perform that function by means not substantially different from that of the patented invention.⁹

In the case of *Carnegie Steel Co. v Cambria Iron Co.*,¹⁰ the Supreme Court held:

This defense presents the common instance of a patent which attracted no attention, and was commercially a failure, being set up as an anticipation of a subsequent patent which has proved a success, because there appears in the mechanism described a possibility of its having been, with some alterations, adaptable to the process thereafter discovered. As heretofore observed, a process patent can only be anticipated by a similar process. It is not sufficient to show a piece of mechanism by which the process might have been performed.¹¹

But this rule cannot govern any case which lacks either of the

8. *Eibel Process Co. v Minnesota & Ontario Paper Co.*, 261 US 45, 67 L Ed 523, 43 S Ct 322 (1923); *Philip v Mayer, Rothkopf Industries, Inc.*, 204 USPQ 753 (1979, ED NY) aff'd (CA2 NY) 635 F2d 1056, 208 USPQ 625.

9. *Eibel Process Co. v Minnesota & Ontario Paper Co.*, 261 US 45, 67 L Ed 523, 43 S Ct 322 (1923); *Topliff v Topliff*, 145 US 156, 36 L Ed 658, 12 S Ct 825 (1892); *Bowers v San Francisco Bridge Co.*, 91 F 381 (1898, CC Cal); *National Hollow Brake-Beam Co. v Interchangeable Brake-Beam Co.*, 106 F 693, 702 (1901, CA8 Mo); *United Shirt & Collar Co. v Beattie*, 149 F 736 (1906, CA2 NY); *H. D. Smith & Co. v Peck, Stow & Wilcox Co.*, 262 F 415 (1919, CA2 Conn); *Rockwood v General Fire Extinguisher Co.*, 8 F2d 682 (1925, CA2 NY); *N. O. Nelson Mfg. Co. v F. E. Myers & Bro. Co.*,

25 F2d 659 (1928, CA6 Tenn); *Gordon Form Lathe Co. v Walcott Mach. Co.*, 32 F2d 55 (1929, CA6 Mich); *W. Bingham Co. v Ware*, 46 F2d 33, 8 USPQ 231 (1931, CA6 Ohio); *United Shoe Machinery Corp. v Day Wood Heel Co.*, 46 F2d 897, 8 USPQ 364 (1931, CA6 Ohio); *Young Radiator Co. v Modine Mfg. Co.*, 55 F2d 545, 12 USPQ 123 (1931, CA7 Wis); *H. W. Peters Co. v MacDonald*, 59 F2d 974, 14 USPQ 87 (1932, CA2 Conn); *John W. Gottschalk Mfg. Co. v Springfield Wire & Tinsel Co.*, 74 F2d 583, 24 USPQ 130 (1935, CA1 Mass); *Firestone Tire & Rubber Co. v United States Rubber Co.*, 79 F2d 948, 27 USPQ 460 (1935, CA6 Ohio).

10. *Carnegie Steel Co. v Cambria Iron Co.*, 185 US 403, 46 L Ed 968, 22 S Ct 698 (1902).

11. 185 US at 421-422.

circumstances upon which it is founded, for negation of novelty is not averted by the mere fact that the inventor of the prior device did not design it to perform the function of the patented device,¹² nor by the mere fact that its ability to perform that function is not apparent to every beholder, nor by the mere fact that it was never actually used for that purpose, nor by any two of these facts combined.¹³ The same principle applies to a prior patent. Although a prior patent may incidentally show a similar arrangement of parts, if that arrangement is not claimed nor designed to perform the function of the later patent, it cannot act as an anticipation.¹⁴

Novelty is not negated by anything which is not designed for the same purpose, where no person using it would understand that it could be put to use in the way the inventor has found.¹⁵

Chance successes without knowing what such successes depended on and without being able to rely on producing them will not anticipate an invention;¹⁶ it has been held sufficient if the prior patentee knew what he had done and could reproduce it.¹⁷ The Supreme Court has held that in order to constitute an

12. *Leonard v Lovell*, 29 F 310 (1886, CC Mich).

13. *Vulcan Corp. v United Shoe Machinery Corp.*, 82 F2d 195, 29 USPQ 70 (1936, CA6 Ohio).

14. *Gray Tel. Pay Station Co. v Baird Mfg. Co.*, 174 F 417 (1909, CA7 Ill); *Beckwith v Malleable Iron Range Co.*, 174 F 1001 (1910, CC Wis) *affd* (CA7 Wis) 189 F 74; *Kryptok Co. v Stead Lens Co.*, 207 F 85 (1913, DC Mo) *affd* (CA8 Mo) 214 F 368; *A. R. Mosler & Co. v Lurie*, 209 F 364 (1913, CA2 NY); *Munising Paper Co. v American Sulphite Pulp Co.*, 228 F 700 (1915, CA6 Mich).

15. *Eames v Andrews*, 122 US 40, 30 L Ed 1064, 7 S Ct 1073 (1887);

Block v Nathan Anklet Support Co., 9 F2d 311 (1925, CA2 NY); *Radio Corp. v Twentieth Century Radio Corp.*, 19 F2d 290 (1927, CA2 NY); *Anderson & Writer Corp. v Hanky Beret, Inc.*, 57 F2d 167, 13 USPQ 273 (1932, CA2 NY).

16. *United Chromium, Inc. v International Silver Co.*, 60 F2d 913, 15 USPQ 51 (1932, CA2 Conn).

17. *Radio Corp. of America v Radio Engineering Laboratories, Inc.*, 1 F Supp 65 (1932, DC NY), *revd on other grounds* (CA2 NY) 66 F2d 768, 19 USPQ 111, *revd on other grounds* 293 US 1, 79 L Ed 163, 54 S Ct 752, *reh den* 293 US 522, 79 L Ed 634, 55 S Ct 66.

anticipation of a later patent, it is enough that the prior construction had been in well established use, whether it originated by design or accident.¹⁸ A patent for a mechanical combination is anticipated by a prior device containing the same elements, although the prior inventor did not describe or appreciate the advantage of using the combination in the way pointed out in the patent.¹⁹

In the case of an accidental showing in a drawing, the anticipatory effect generally depends on the facts of each case.²⁰ It has been held that if the drawing clearly suggests to one skilled in the art the way in which the result is accomplished, it is immaterial whether such showing was accidental or unintentional.¹ In the Patent Office, the Board of Appeals has ruled that an accidental disclosure in the prior art, if clearly shown, is available as a reference.² It is immaterial whether the prior patentee realized the full potential of his device.³ There is no anticipation where the alleged anticipation, to accomplish the patented result, remains the sport of accident.⁴

The case of *Bird Provision Co. v Owens Country Sausage, Inc.*⁵ discussed the rule applied in *Tilghman* and *Eibel Process* when the court held invalid the Vogel patent on a process of preparing and packaging fresh pork sausage. The court said:

18. *Smith v Hall*, 301 US 216, 81 L Ed 1049, 57 S Ct 711, 33 USPQ 249 (1937).

19. *Consolidated Bunting Apparatus Co. v Metropolitan Brewing Co.*, 60 F 93 (1894, CA2 NY).

20. *Re Bager*, 18 CCPA 1094, 47 F2d 951, 8 USPQ 484 (1931).

1. *Re Wagner*, 20 CCPA 985, 63 F2d 987 (1933); *Mooney v Brunswick Corp.*, 489 F Supp 544, 206 USPQ 121 (1980, ED Wis) affd (CA7 Wis) 663 F2d 724, 212 USPQ 401.

2. *Ex parte Brinton*, 82 USPQ 112 (1948, Bd App).

3. *Anderson v Phoenix Products Co.*, 226 F2d 191, 107 USPQ 66 (1955, CA7 Wis); *Mooney v Brunswick Corp.*, 489 F Supp 544, 206 USPQ 121 (1980, ED Wis) affd (CA7 Wis) 663 F2d 724, 212 USPQ 401.

4. *Tile Council of America, Inc. v Ceramic Tilers Supply, Inc.*, 257 F Supp 339, 149 USPQ 398 (1965, SD Cal).

5. *Bird Provision Co. v Owens Country Sausage, Inc.*, 568 F2d 369, 197 USPQ 134 (1978, CA5 Tex).

The rule applied in *Tilghman* and *Eibel Process* is founded on the policy of rewarding persons who teach the public how to perform processes and construct things that nobody else knows how to perform or construct. (Citation omitted) When the process has been in well-established use, however, novelty is destroyed even though some of the benefits of the process are not recognized or appreciated. (Citations omitted) In the instant case there is substantial evidence that the identical process claimed by the Bird Provision patent had previously been used for the same purpose: producing and preserving fresh pork sausage. The prior users did not employ the process by chance. They were not unaware of the fact that they had hot-processed the meat into saran and other air-impermeable containers. That the prior public users did not understand or appreciate the shelf life implications of the process does not save the Bird Provision patent from anticipation under § 102(b), for the discovery of the process' shelf life implications involved nothing that was new in its use or method of application.⁶

Novelty is not negated by unrecognized or unappreciated, or unintentional, accidental prior use.⁷

It has been held that prior production of an invention does not constitute an anticipation unless its function and character are understood by those skilled in the art.⁸ Anticipatory prior knowledge or use of an invention cannot arise from prior accidental production of the same thing, when the operator does not recognize the means by which the accidental result is accomplished, and no knowledge of them, or of the method of

6. 197 USPQ at 139.

7. *Eibel Process Co. v Minnesota & Ontario Paper Co.*, 261 US 45, 67 L Ed 523, 43 S Ct 322 (1923); *Metal Cutting Tool Service v National Tool Co.*, 103 F2d 581, 41 USPQ 688 (1939, CA6 Ohio); *United Chromium, Inc. v International Silver Co.*, 15 USPQ 51, 60 F2d 913 (1932, CA2 Conn); *Doble v Pelton Water Wheel Co.*, 186 F 526 (1910, CC Cal) affd (CA9 Cal) 190 F 760; *Edison Electric Light Co. v Novelty*

Incandescent Lamp Co., 167 F 977 (1909, CA3 Pa); *Hillard v Fisher Book Typewriter Co.*, 159 F 439 (1908, CA2 NY); *International Nickel Co. v Ford Motor Co.*, 166 F Supp 551, 119 USPQ 72 (1958, DC NY).

8. *Cleveland Trust Co. v Schriber-Schroth Co.*, 108 F2d 109, 43 USPQ 204 (1940, CA6 Ohio) revd on other grounds 311 US 211, 85 L Ed 132, 61 S Ct 235, 47 USPQ 345; *McKee v Graton & Knight Co.*, 87 F2d 262, 32 USPQ 89 (1937, CA4 NC).

their employment, is derived from the prior use by anyone until the date of the invention.⁹ It has been held sufficient for anticipation that the prior patentee knew what he had done and could reproduce it.¹⁰

To constitute anticipation, it is enough that the prior construction or use has been in well-established use, whether it originated by design or accident.¹¹ In the case of a process, it is sufficient that the process be disclosed in the prior art, even though all the results of the process were not known. Thus, in *Celite Corp. v Dicalite Co.*,¹² the patent in suit was directed to a certain treatment of diatomaceous earth to produce a product adapted as a filter aid of high flow rate capacity. The North patent, held anticipatory, disclosed the same method of treatment for the purpose of removing organic matter and bleaching the product. The court said that: "as the patented process in suit was disclosed by the North patent, it was anticipated by that process even though it be assumed that the North patent failed to state, and that North did not know, of the increased flow rate of the product produced." In a case in the Second Circuit, a patent for a mechanical combination was held anticipated by a prior device containing the same elements, although the inventor of the prior device did not describe or appreciate

9. *Smith v Prutton*, 127 F2d 79, 53 USPQ 412 (1942, CA6 Ohio); *Cleveland Trust Co. v Schriber-Schroth Co.*, supra; *J. C. Ferguson Mfg. Works, Inc. v American Lecithin Co.*, 94 F2d 729, 37 USPQ 4 (1938, CA1 RI) cert den 304 US 573, 82 L Ed 1537, 58 S Ct 1042; *H. K. Regar & Sons v Scott & Williams, Inc.*, 63 F2d 229, 17 USPQ 81 (1933, CA2 NY); *United Chromium v International Silver Co.*, supra; *Re Bager*, 18 CCPA 1094, 47 F2d 951, 8 USPQ 484 (1931); *Janette v Folds*, 17 CCPA 879, 38 F2d 361 (1930).

10. *Radio Corp. of America v*

Radio Engineering Laboratories, Inc., 1 F Supp 65, 1 USPQ 305 (1932, DC NY) revd on other grounds (CA2 NY) 66 F2d 768, revd on other grounds 293 US 1, 79 L Ed 163, 54 S Ct 752, reh den 293 US 522, 79 L Ed 634, 55 S Ct 66.

11. *Smith v Hall*, 301 US 216, 81 L Ed 1049, 57 S Ct 711, 33 USPQ 249 (1937); *Carson v American Smelting & Refining Co.*, 11 F2d 766 (1926, CA9); *National Harrow Co. v Quick*, 74 F 236 (1896, CA7 Ind).

12. *Celite Corp. v Dicalite Co.*, 96 F2d 242, 37 USPQ 383 (1938, CA9 Cal).

the advantage of using the combination in the way pointed out in the patent.¹³

When a result is the necessary consequence of what was deliberately intended, such result will anticipate the subsequent process, regardless of whether the result was then valueless for the purposes in mind.¹⁴ The Supreme Court has held that it is immaterial that a new form of result had not before been contemplated.¹⁵

III. Prior Knowledge, Use or Sale

§ 4:10 Knowledge or Use; Generally

No valid patent can be obtained by an inventor for his invention if it was known by others in this country before his invention or discovery thereof.¹⁶ This is true of both domestic and foreign inventions¹⁷ It is immaterial that the earlier invention was not the subject of a patent.¹⁸ The mere fact that the inventor was ignorant of the anticipatory matter is immaterial.¹⁹

At common law the right of property of an inventor in his

13. Consolidated Bunting Apparatus Co. v Metropolitan Brewing Co., 60 F 93 (1894, CA2 NY).

14. Regar & Sons v Scott & Williams, supra.

15. Ansonia Brass & Copper Co. v Electrical Supply Co., 144 US 11, 36 L Ed 327, 12 S Ct 601 (1892); American Sales Book Co. v Carter-Crume Co., 150 F 333 (1906, CA2 NY).

16. 35 USCS § 102(a) states:

"A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent."

17. Welsbach Light Co. v American Incandescent Lamp Co., 98 F 613 (1899, CA2 NY).

18. Micon v Burton-Dixie Corp., 147 F2d 19, 64 USPQ 355 (1945, CA7 Ill); Simmons v Hansen, 117 F2d 49, 48 USPQ 345 (1941, CA8 Iowa); American Lakes Paper Co. v Nekoosa-Edwards Paper Co., 83 F2d 847, 29 USPQ 551 (1936, CA7 Wis); Dunlop Co. v Kelsey-Hayes Co., 484 F2d 407, 179 USPQ 129 (1973, CA6 Mich).

19. Simmons v Hanson, supra; Pennington v National Supply Co., 95 F2d 291, 37 USPQ 18 (1938, CA5 Tex); John T. Riddell, Inc. v P. Goldsmith Sons Co., 92 F2d 353, 36 USPQ 7 (1937, CA6 Ohio).